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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,288	06/24/2003	Pierre Albou	1948-4808	3252
27123	7590	04/20/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			CHOI, JACOB Y	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/603,288	Applicant(s) ALBOU, PIERRE	
	Examiner Jacob Y. Choi	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 9-14, 19 and 20 are rejected under 35 U.S.C. 102(b) & 35 U.S.C. 102 (e) as being anticipated by Lindae et al. (USPAN 4,796,171).

Regarding claim 1, Lindae et al. discloses a reflector (10), a light source (1112) producing a set of light signals which can be reflected by the reflector, an exit lens (15), comprising an entry surface and an exit surface, for producing a light beam, and a shield (13) disposed between the reflector and the exit lens in order to produce a cutoff in the light beam produced, wherein the exit lens comprises a set of protuberances (Figures 2, 4, 6-8) produced in at least one side part of the exit surface of the lens, each arrangement being able to divert in a given direction a part of the light signals encountering this protuberances, the protuberances being produced on the side parts of the exit surface of the exit lens.

Regarding claim 2, Lindae et al. discloses the diversion direction are directions situated above the cutoff.

Regarding claim 3, Lindae et al. discloses each protuberances is able to divert some of the light signals encountering this arrangement in a direction corresponding to a gantry point.

Regarding claim 9, Lindae et al. discloses the exit lens comprises several protuberances able to divert some of the light signals in the same given direction.

Regarding claim 10, Lindae et al. discloses each protuberances produced in the exit surface of the exit lens has an end situated at the periphery of the exit lens.

Regarding claim 11, Lindae et al. discloses the protuberances produced in the exit surface of the exit lens are disposed on the exit surface of the exit lens symmetrically with respect to a vertical axis of the exit lens.

Regarding claim 12, Lindae et al. discloses at least one of the protuberances is produced in the form of a flute.

Regarding claim 13, Lindae et al. discloses an automobile equipped with a projection device.

Regarding claim 14, Lindae et al. discloses the exit surface comprises a central part disposed at least partially within the vertical plane (65) defined by the optical axis (12), and a first and second side parts (Figures 9a-9d; first part is located left of (65) and second part is located right of (65)), the side part being disposed on opposing sides of the vertical plane, and wherein the protuberances are produced solely on these side parts.

Regarding claim 19, Lindae et al. discloses each of the protuberances produced in the exit surface of the exit lens has an end situated in an immediate vicinity of a periphery of the exit lens.

Regarding claim 20, Lindae discloses a light source (11) adapted to emit light, a reflector (10) disposed to receive and reflect light generated by the light source to form a light beam having an optical axis (12), an exit lens (15) disposed in the path of the light beam, the lens having an entry surface facing the light source and an opposing exit surface, the exit surface having central part disposed at least partially within a vertical plane defined by the optical axis, and first and second side parts, the side parts being disposed on opposing sides of the vertical planes (Figures 9a-9d), a shield (13) disposed between the reflector and the exit lens in order to produce a cutoff in the light beam produced, wherein the exit lens further comprises a plurality of modified surface regions having tangent planes that differ from adjacent surfaces of the lens, the modified surface region being produced on at least one of the side parts of the exit surface of the lens, each of the modified surface regions being able to divert in a given direction a part of the light signals encountering this modified surface region.

3. Claims 1-3, 9-13, and 19 are rejected under 35 U.S.C. 102(b) & 35 U.S.C. 102 (e) as being anticipated by Uchida (USPN 6,416,210).

Regarding claim 1, Uchida discloses a reflector (14), a light source (12) producing a set of light signals which can be reflected by the reflector, an exit lens (18), comprising an entry surface and an exit surface, for producing a light beam, and a

shield (22) disposed between the reflector and the exit lens in order to produce a cutoff in the light beam produced, wherein the exit lens comprises a set of protuberances (Figure 18s) produced in at least one side part of the exit surface of the lens, each arrangement being able to divert in a given direction a part of the light signals encountering this protuberances, the protuberances being produced on the side parts of the exit surface of the exit lens.

Regarding claim 2, Uchida discloses the diversion direction are directions situated above the cutoff.

Regarding claim 3, Uchida discloses each protuberances is able to divert some of the light signals encountering this arrangement in a direction corresponding to a gantry point.

Regarding claim 9, Uchida discloses the exit lens comprises several protuberances able to divert some of the light signals in the same given direction.

Regarding claim 10, Uchida discloses each protuberances produced in the exit surface of the exit lens has an end situated at the periphery of the exit lens.

Regarding claim 11, Uchida discloses the protuberances produced in the exit surface of the exit lens are disposed on the exit surface of the exit lens symmetrically with respect to a vertical axis of the exit lens.

Regarding claim 12, Uchida discloses at least one of the protuberances is produced in the form of a flute.

Regarding claim 13, Uchida discloses an automobile equipped with a projection device.

Regarding claim 19, Uchida discloses each of the protuberances produced in the exit surface of the exit lens has an end situated in an immediate vicinity of a periphery of the exit lens.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-8 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Lindae et al. (USPAN 4,796,171) or Uchida (USPN 6,416,210).

Regarding claims 5, 15 and 16, either Lindae et al. or Uchida discloses claimed invention, except the specific thickness of protuberances.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify thickness of the protuberance, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 6-8, 17 and 18, either Lindae et al. or Uchida discloses claimed invention except for the specific number of protuberances.

Lindae et al. teaches different arrangements of the so-called microelements (Figures 9a-9d) and either Lindae et al. or Uchida teaches several numbers of protuberances situated on exit side of the lens.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate number of arrangements on the lens, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Also, It would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the arrangements on the lens, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Response to Amendment

6. Examiner acknowledges that the applicant has canceled claim 4, amended claims 1, 3, 5-12 and newly added claims 14-20.

Response to Arguments

7. Applicant's arguments filed 1/27/2005 have been fully considered but they are not persuasive.

Examiner respectfully disagrees with applicant's arguments regards rejections of claims 1-13 as being anticipated by, or unpatentable over Lindae or Uchida.

Claim 1 recites: "... wherein exit lens comprises a set of protuberances produces in at least one side part of the exit surface of the lens, each arrangement being able to divert in a given direction a part of the light signals encountering this protuberances, the protuberances being produced on the side parts of the exit surface of the exit lens."

First, it has been held that the recitation that an element is "able to" performing a function is not appositive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Also "divert in a given direction" is given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). Lindae discloses the corresponding lens formula (column 3, 29-59) with its specified range of angles to reduce the light dark boundary zone of the light beam (column 4, lines 10-43). Following disclosure anticipates broad claim language of "able to divert in a given direction", where a "given direction" may be any direction that is sufficiently provided by so called microelements of Lindae et al. Clearly, Lindae et al. anticipates applicant's claimed limitations of "exit lens comprises a set of protuberances produced in at least one side part of the exit surface of the lens", shown in Figures 1, 6 and 9).

Second, similarly, Uchida lens elements (18s) not only are concentrated on the central part of the lens but it extends along the horizontal direction to the edge of the lens (Figure 4), meaning, following limitation anticipates applicant's "exit lens comprises a set of protuberances produced in at least one side part of the exit surface of the lens". In addition, light signals produced by the light source are able to divert in a given direction by passing protuberances arrangement of Uchida. In order to be given

patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Note: Protuberance - something, such as a bulge, knob, or swelling, that protrudes.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC



JOHN ANTHONY WARD
PRIMARY EXAMINER